

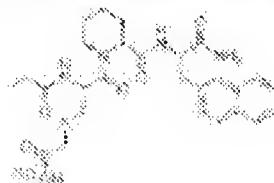
DETAILED ACTION

Claims 1-5, 8-17 and new claims 45-48 are under examination.

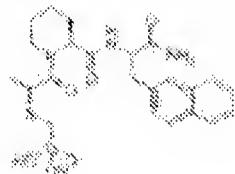
Claims 19-43 are withdrawn.

The claims have not been amended to the restricted group.

Group 1, namely 1-17 in part, drawn to compounds and pharmaceutical compositions wherein the compound(s) or the core structure of the methiodine linked to the piperidine and the

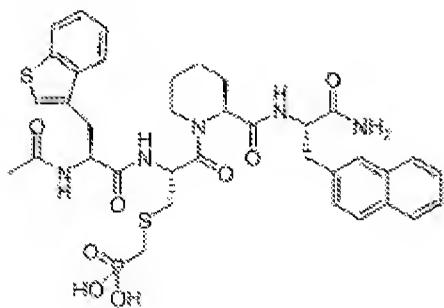


phenomena group as given in table 13 and so given below.



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Applicants have elected example 2 in table 1 and 2.



The claims still include non-elected matter.

Arguments regarding the scope of enablement :

Applicants argues that an enablement requirement is satisfied when an application describes a claimed invention in a manner that permits one of ordinary skill in the art to practice it without undue experimentation. The mere fact that experimentation is needed is insufficient to support the enablement requirement and that complex experimentation is not necessarily overdue.

Applicants further argue that the core is a piperidine formed by Q, T, U and V.

The examiner disagrees. The bond between T and U may be a double bond or a single bond or absent. So when it is absent or if it a double bond it cannot be a piperidine.

Then applicants also say that that proper markush language has now been incorporated in the claims.

These arguments and amendments still do not overcome the rejection. As previously stated the ring does not have to be a piperidine. The groups A1-A9 can be present from a variety of groups or absent. Coupled with the variety of substituents the various R's and A groups can have it is not clear how one can enable these compounds. The starting material for this scope of compounds is also not given.

The present claims relate to an extremely large number of possible compounds. Only a very small proportion of the compounds, namely the compounds specifically mentioned in the description and covered by claim

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13 are enabled. The claims are drawn to solvates, yet the numerous examples presented all failed to produce a solvate. These cannot be simply willed into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190 “The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However ... there is no evidence that such compounds exist... the examples of the '881 patent do not produce the postulated compounds... there is ... no evidence that such compounds even exist.” The same circumstance appears to be true here. There is no evidence that solvates of these compounds actually exist; if they did, they would have formed. Hence, applicants must show that solvates can be made, or limit the claims accordingly.

The rejection is still maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA DESAI whose telephone number is (571)272-0684. The examiner can normally be reached on Maxi- flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

June 27, 2011.